



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,298	09/27/2001	Dennis J. O'Rear	005950-657	5063

7590 03/10/2003

E. Joseph Gess
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

[REDACTED] EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
1764	6

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NW

Office Action Summary	Application No.	Applicant(s)
	09/966,298	O'REAR, DENNIS J.
	Examiner	Art Unit
	Ellen M McAvoy	1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 December 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	6) <input type="checkbox"/> Other: _____ .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,080,301) or Berlowitz et al (6,165,949).

Applicant's arguments filed 23 December 2002 have been fully considered but they are not persuasive. As set forth in the previous office action, the Berlowitz et al ["Berlowitz"] references disclose premium synthetic lubricating oil basestocks having a high viscosity index (VI) and low pour point which contain at least 95% by weight of non-cyclic isoparaffins. The lubricant basestocks are produced by hydroisomerizing waxy, Fischer-Tropsch synthetized hydrocarbons. See column 1, line 8, to column 2, line 14, of Berlowitz '301 and column 1, lines 5-65 and column 4, lines 23-28 of Berlowitz '949. The lubricant basestocks contain sulfur, nitrogen and metals in amounts of less than 1 ppm by weight. The examiner maintains the position that these premium synthetic basestocks clearly meet the limitation of component (a) of the claims. The lubricant basestocks of the Berlowitz references may be mixed or blended with one or more additional basestocks selected from the group consisting of (a) hydrocarbonaceous base stock, (b) a synthetic base stock, and mixtures thereof. Typical examples include base stocks derived from (i) poly-alpha-olefins, (ii) conventional mineral oils, (iii) mineral oil slack wax hydroisomerates, and mixtures thereof. See column 2, lines 25-44, and column 5, top, of

Berlowitz '301 and column 5, lines 43-56 of Berlowitz '949. Although the Berlowitz references do not classify the additional blended basestocks in terms of Groups I-V, applicant teaches in the specification on page 5 that the majority of lube production is in the Group I category which designates lube base oils containing greater than 300 ppm sulfur, a saturate content of less than 90% and a viscosity index of between 80-120. And, as set forth in Berlowitz '301, by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil. Thus, the examiner maintains the position that the premium basestock blends of the Berlowitz references clearly meet the limitations of the lube base oil blends of the claims.

Applicant argues that his invention is directed to a lube base oil comprising at least one synthetic lube base oil and at least one percent of a non-synthetic lube base oil wherein the lube base oil has a greater stability in the absence of additives than the stability of the synthetic lube base oil. Applicant argues that the invention of the claims lies in selecting the non-synthetic lube base oil and blending it with the synthetic, where the selecting and blending are done with a focus on improving the properties of the synthetic lube base oil. This is not deemed to be persuasive of patentability of the claims because the lube base oil blends may be the same. Component a) of applicants invention, which may comprise up to 99% of the blend, is the same as the Fischer-Tropsch derived iso-paraffin synthetic base oil taught by Berlowitz; and component b) of applicants invention, at least 1 % of a non-synthetic lube base oil which is selected from Group I lube base oils, Group II lube base oils and Group V base oils, is indistinguishable from the blending base stocks of Berlowitz which broadly comprise

hydrocarbonaceous base stocks. As set forth above, the hydrocarbonaceous base stocks are primarily hydrocarbon type base stocks derived from a conventional mineral oil which is exactly what Group I lube base oils are. The claims include the proviso that the lube base oil blend has “a greater stability” than the oil components alone. It is not clear what is meant by the relative term “greater stability” of the claims, the measure of stability is not set forth, and it is not clear that the oil blends of Berlowitz do not also have the same “greater stability”. In the passage quoted by applicant, the Berlowitz patents state that the blended lubricant oil “will still provide superior properties in many most cases, although to a lesser degree than only if the base stock of the invention is used”. The “properties” are not set forth so it is not clear if stability was a property tested, and the phrase “in many most cases” indicates that not in all cases is the statement accurate. Thus, for the reasons set forth, the examiner is of the position that a clear line of distinction between applicant’s claimed invention and the applied prior art references is not seen to exist.

Claim Rejections - 35 USC § 103

Claims 1-12 are also still rejected under 35 U.S.C. 103(a) as being unpatentable over Wittenbrink et al (6,332,974).

Applicants arguments filed 23 December 2002 have been fully considered but they are not deemed to be persuasive. As set forth in the previous office action, Wittenbrink et al [“Wittenbrink”] disclose a wide-cut lubricant base stock having a low pour point and high viscosity index (VI) which is made by hydroisomerizing and then catalytically dewaxing a waxy

Fischer-Tropsch synthesized hydrocarbon fraction. The base stock comprises at least 95% by weight of non-cyclic isoparaffins. See column 4, lines 5-38. The base stocks of Wittenbrink may also be blended with an additional lubricant base stock which may be selected from the group consisting of (i) a hydrocarbonaceous base stock, (ii) a synthetic base stock and mixtures thereof. See column 4, lines 33-50. Wittenbrink teaches that by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil, shale oil, tar, coal liquefaction, and mineral oil derived slack wax. Thus the examiner maintains the position that Witttenbrink also clearly meets the limitations of the claimed lubricant base oil blends.

Applicant argues that his invention is directed to a lube base oil comprising at least one synthetic lube base oil and at least one percent of a non-synthetic lube base oil wherein the lube base oil has a greater stability in the absence of additives than the stability of the synthetic lube base oil. Applicant argues that the invention of the claims lies in selecting the non-synthetic lube base oil and blending it with the synthetic, where the selecting and blending are done with a focus on improving the properties of the synthetic lube base oil. This is not deemed to be persuasive of patentability of the claims because, as set forth above, the lube base oil blends may be the same. Component a) of applicant's invention, which may comprise up to 99% of the blend, is the same as the Fischer-Tropsch derived iso-paraffin synthetic base oil taught by Wittenbrink; and component b) of applicant's invention, at least 1 % of a non-synthetic lube base oil which is selected from Group I lube base oils, Group II lube base oils and Group V base oils, is indistinguishable from the blending base stocks of Wittenbrink which broadly comprise

hydrocarbonaceous base stocks. As set forth above, the hydrocarbonaceous base stocks are primarily hydrocarbon type base stocks derived from a conventional mineral oil which is exactly what Group I lube base oils are. The claims include the proviso that the lube base oil blend has “a greater stability” than the oil components alone. It is not clear what is meant by the relative term “greater stability” of the claims, the measure of stability is not set forth, and it is not clear that the oil blends of Wittenbrink do not also have the same “greater stability”. In the passage quoted by applicant, the Wittenbrink patent states that the blended lubricant oil “will still provide superior properties in many most cases, although to a lesser degree than only if the base stock of the invention is used”. The “properties” are not set forth so it is not clear if stability was a property tested, and the phrase “in many most cases” indicates that not in all cases is the statement accurate. Thus, for the reasons set forth, the examiner is of the position that a clear line of distinction between applicant’s claimed invention and the applied prior art references is not seen to exist.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

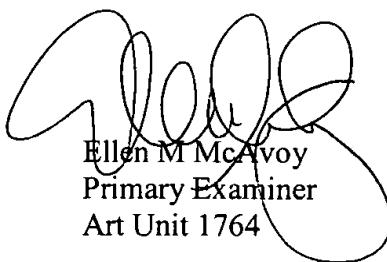
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 4, 2003